

REMARKS**I. Status of Claims**

Claims 1 through 5, inclusive, are pending in this application. Claim 1 has been amended in this response.

II. Response to the 35 U.S.C. §112 Rejections

The rejections of claims 1-5, inclusive, under 35 U.S.C. §112 are respectfully traversed.

In respect of the rejection relating to alleged omitted steps, it was thought that the requirement in lines 1 and 2 of original claim 1 of "recovering multiple separate tripropylene glycol products" when read in the light of the specification would make such steps obvious to one skilled in the art. However, to further emphasize this distinction, claim 1 has been amended to recite the step of deliberately keeping the first stream physically separate from the second stream. This is supported by the original specification, page 6, line 30, and page 7, line 1. In this same regard, claim 1 has also been amended to recite the separate removal of the second stream concentrate to a separate processing step to form a second separate individual TPG product that contains essentially no neutralizing additive. This is supported by original claim 2 and the original specification, page 7, lines 11-18. Accordingly, reconsideration and withdrawal of this rejection is requested.

In respect of the rejection relating to the use of the terms "composition" and "material" in claim 1, the Examiner's comment is well taken, and the term "material" in that claim has been changed to "composition" to meet the Examiner's requirement. Accordingly, reconsideration and withdrawal of this rejection is requested.

III. Response to the 35 U.S.C. §103 Rejection

The rejection of claims 1-5, inclusive, as unpatentable under 35 U.S.C. §103(a) over Applicant's admission of the prior art in view of Gupta et al. (U.S. Pat. No. 5,672,768) and Broussard et al. (U.S. Pat. No. 3,989,740) is respectfully traversed.

The Examiner's argument, particularly in the last paragraph on page 4 and bridging over to page 5 of the action, turns on the premise that it would have been obvious to one skilled in the art to add a neutralizing agent such as NaBH₄ to a polyalkylene glycol stream to remove aldehyde there from. Applicant agrees with this premise. However, this premise is emphatically not the invention that was set forth in Applicant's original specification and claims.

The prior art described in Applicant's original disclosure clearly states that the prior art process produced a single TPG product that contains essentially no neutralizing agent, original specification; page 3, lines 8 and 9; page 5, lines 18 and 19; and page 6, lines 6 and 7.

In clear distinction to the prior art single product process, it was disclosed that Applicant's invention is a series of process steps that produce two separate final TPG products, one of which contains neutralizing agent, original specification; page 3, lines 15-20; page 6, line 27 through page 7, line 18; and page 8, lines 4-7.

Accordingly, Applicant's inventive process, when taken as a whole, is a series of processing steps that produces two separate, final TPG products, one of which contains neutralizing agent. This is clearly not the simple step of using a neutralizing agent to reduce the aldehyde content of a polyalkylene stream. Nor are Applicant's claimed series of process steps disclosed by the prior art relied upon.

Accordingly, the whole of Applicant's claimed process is novel over the prior art combination relied upon by the Examiner and is not suggested in any form or manner by that prior art when read individually or in any combination.

Applicant's process, taken as a whole, produces not one but two separate products, one of which, unlike the prior art, contains a neutralizing additive and one of which, like the prior art, is essentially free of such an additive. This novel, multi-product process provides numerous advantages such as cost savings, process flexibility, and bottoms disposal efficiencies; original specification page 3, lines 21-29; page 4, lines 1-11; page 5, lines 14-22; page 6, lines 6-11; and page 8, lines 4-9. None of these advantages are suggested, implied, or even hinted at by the prior art relied upon when taken individually or in any combination thereof.

Gupta et al. and Broussard et al. each disclose the production of a single product, do not suggest a multi-product where one of the products contains neutralizing agent and the other does not, and do not suggest any of the advantages of such a two product process. Thus, this prior art, no matter how it is combined with Applicant's honest admissions, does not suggest in any way a two product process where one of the products contains neutralizing agent and the other does not.

The legal test which must be applied here is that of obviousness of the invention when taken as a whole, not obviousness of a single piece that is dissected out after considering Applicant's disclosure, Harpman v. Watson, 124 USPQ 169. The separation out of the single step of adding a neutralizing agent to reduce aldehydes in a polyalkylene stream is a classical violation of the Harpman v. Watson doctrine.

Notwithstanding a comprehensive application of Applicant's honest admission plus two separate and relatively unrelated patents, there is still a wide and significant gap between the invention as claimed and what the prior art combination fairly suggests to one skilled in the art. This gap is that there is no suggestion or hint in the prior art combination, when read without an improper retroactive reliance on Applicant's disclosure, of a series of process steps which produces two separate products, one of which contains a neutralizing agent, and the motivating advantages for producing these two

separate and distinct products. To urge that it is obvious to do what Applicant has claimed, in spite of this gap, is to assume Applicant's invention rather than to find the teaching or reason in the art which one skilled in the art needs under the law, *In re Soli*, 137 USPQ 797.

Further, the combination of patents relied upon is improper under the law. *Gupta et al.* and *Broussard et al.*, when taken individually or in any combination, do not suggest Applicant's claimed two product process. Nor do they provide in their disclosures any motivation for their combination. The only motivation for their combination is an improper reliance on Applicant's disclosure. It has been continually held that references may not be combined where there is no suggestion in any of them that they can be combined to produce Applicant's result, *Tietig et al. v. Ladd*, 141 USPQ 372.

A careful study of both *Gupta et al.* and *Broussard et al.* and the manner in which the Examiner combines them utterly fails to suggest Applicant's claimed process as a whole, and there is no suggestion in these patents themselves that they can be or should be combined in the absence of an improper reliance on Applicant's disclosure. This is clearly improper under the law, *Ex parte Lennox*, 144 USPQ 224.

In view of the foregoing, it is clear that the Examiner has failed to carry the burden of establishing a prima facie case of obviousness. The Examiner has provided no motivation for modifying the single product process of the prior art to provide the two-product process set forth in Applicant's claims.

Accordingly, reconsideration and withdrawal of this rejection is requested.

Schlesinger et al. and *Randall et al.* have been considered but are deemed to be distinguished over for reasons similar to those set forth here in above.

Wherefore, it is submitted that this application is now in condition for immediate allowance, and such action is hereby requested.

Respectfully submitted,
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December 22, 2004
CUSTOMER NUMBER: 24114